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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,396	01/09/2004	Victor Fuk-Pong Man	163.1877US01	7958
23552	7590	01/18/2008		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER CORBIN, ARTHUR L	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			01/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/754,396

**Applicant(s)**

MAN ET AL.

**Examiner**

Arthur L. Corbin

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04-26& 05-03-04,06-09&07-28-05,10-30-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Responsive to 04-10-07 IDS</u> .       |

1. The restriction requirement dated August 8, 2007 is hereby vacated and the following restriction requirement rendered:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a method of treating poultry with an antimicrobial composition and recycling water used in said method, classified in class 426, subclass 332.
- II. Claim 5-7, drawn to an antimicrobial composition, classified in class 514, subclass 557.

2. The inventions are independent or distinct, each from the other because:

1a. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the composition as claimed can be used in a materially different process, e.g. a process of treating produce/vegetable/plant products.

2a. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

3. During a telephone conversation with Mr. Skoog on January 11, 2008 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-7 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hilgren et al (6,514,556, cols. 2-4, 6, 7, 9-12, 14, 16-18, 20, 21). Hilgren et al discloses a method of treating poultry with an aqueous composition to reduce microbial contamination and then recovering and treating the aqueous composition used in the treatment in order to prepare the composition for reuse. The aqueous composition used in both treatments includes peroxyoctanoic acid and peroxyacetic acid (Abstract), octanoic acid, water, polyalkylene oxide (nonionic surfactant), hydrogen peroxide (oxidizing agent), sequestrant, e.g. EDTA, and an anionic surfactant. The surfactants, i.e. emulsifiers, may result in a foaming version of the composition. Applicant's claimed ratio (claim 1, last 2 lines) and the claimed amount of each component in the composition, except for the water, is disclosed by Hilgren et al. Finding the optimum amount of water to use in said composition would require nothing more than routine experimentation by one reasonably skilled in this art.

6. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilgren et al as applied to claim 1 above, and taken with or without Oakes et al. Without Oakes et al, it would have been obvious to prepare the peroxyacetic acid in Hilgren et al in situ by combining acetic anhydride, hydrogen peroxide and sulfuric acid as disclosed in col. 6, lines 37-39 of Hilgren et al. Thus, an inorganic acid, as claimed by applicant in claims 2-4, would also be initially present in said composition. With Oakes et al, it would have been obvious to include an inorganic acid, e.g. phosphoric acid, in said

composition in order to lower the pH thereof since it is conventional to include phosphoric acid in a peroxycarboxylic acid (e.g. peroxyoctanoic acid) containing antimicrobial composition for pH control, as evidenced by Oakes et al (col. 4, lines 5-17). Further, it would have been obvious that a microemulsion (claim 3) can be present in the composition of Hilgren et al since a foaming version thereof can be used (Hilgren et al, col. 20, lines 53-67) and since a surfactant emulsion former is present in the composition of Hilgren et al (col. 14). Finding the optimum amount of inorganic acid to be included would require nothing more than routine experimentation by one reasonably skilled in this art.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the method claims in

each of copending Application Nos. 10/754,436; 11/029,235; 11/030,271; 11/030,233; 10/823,005; 10/357,666 and 10/754,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to treat poultry as the product being treated in the method claims in each of said applications since poultry is well known to contain microbial contamination. Further, it would have been obvious to use any predetermined amount of each component in the compositions claimed in each of said applications simply depending upon desired results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-4 are further provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 33, 292, 293, 298, 299, 304 and 305 of copending Application Nos. 11/978,972 and 11/980,077. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth in paragraph no. 8 above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each Hilgren et al patent (US 2002/0119743; 7,316,824; 7,150,884 and 6,627,657) shows a method of reducing microbes by using various compositions including peroxyoctanoic acid. Swart et al shows reducing microbes on as food product by treating with peroxyoctanoic acid and irradiating the food product.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur L. Corbin  
Primary Examiner  
Art Unit 1794

1-15-08



Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:042604,050304,060905,072805,103006,041007.